

REMARKS

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (i.e., Claims 35-64) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, it should be recognized that the present invention relates to a computer software program for a document management system, that tracks and allows for searching of various documents from creation to destruction of the documents, particularly in large, or enterprise, organizations, but also for medium-sized and small organizations. As broadly claimed, the present invention provides a document management extension system for use as an extension to a document collection and management software program, which includes a database for storing documents managed by a document collection and management software program, as well as means for document indexing of the database of stored documents and means for processing the stored documents in the database.

While not essential, the document management extension system of the invention is preferably used in combination with Microsoft Exchange, which the document management extension system merges the functionality of index databases, file repositories and messaging systems using Microsoft Exchange, while leveraging the tight integration of Microsoft Exchange

and an NT Server for security and redundancy management. This would include a user interface, which is accessed through dialogs in specific software application programs or through a "find" application.

As will be explained in greater detail hereinafter, nowhere in the prior art is such an efficient and useful document management extension software program, for management of documents in organizations of all sizes, and which may usefully be employed with Microsoft Exchange, either disclosed or suggested.

By the present amendments, Applicants have cancelled prior Claims 1-34 and have substituted therefor new Claims 35-64, of which Claim 35 is now the main independent claim pending in the instant patent application. The claims have been rewritten to remove the use of trademarks originally found in the claims and for conformance with U.S. practice.

The Examiner had rejected Claim 1 (and all remaining claims via dependency), pursuant to 35 U.S.C. §112, second paragraph, as indefinite, due to the Australian claim format, which did not clearly distinguish the claim preamble from the body of the claim by way of a proper transitional word or phrase. Further, the use of trademarks within the claims is generally understood to be indefinite under U.S. patent law, as discussed in Ex parte Simpson, 218 USPQ 1020 (PTO Board of Appeals 1982).

The grounds for the Examiner's indefiniteness rejection of the first Office Action, Applicants respectfully submit, are overcome by the entry of new Claims 35-64 and, consequently, Applicants request withdrawal of the Examiner's 35 U.S.C. §112, second paragraph, indefiniteness rejection.

Applicants have also amended their Specification to indicate the use of trademarks therein, including capitalization of all trademarks and inclusion in the disclosure of the generic terminology for the goods represented by the trademarks used, as appropriate, at various points in the Specification, as required by the Examiner at Pages 7 - 8 of the first Office Action.

Applicants have also included, on a separate sheet of paper, an Abstract in conformance with 37 C.F.R. §1.72(b), for use with the present patent application.

Turning now, in detail, to an analysis of the Examiner's prior art rejection, in the first Office Action the Examiner has rejected the subject matter of prior Claims 1-34 (now Claims 35-64) as being obvious, pursuant to 35 U.S.C. §103(a), over Porter et al., U.S. Patent No. 5,845,067; Nishiyama et al., U.S. Patent No. 5,568,640; and Tada et al., U.S. Patent No. 5,887,171, taken in combination with one another. The Examiner has expressed the view that Porter et al. teaches a method and apparatus for document management utilizing a messaging system. The Examiner has, however,

acknowledged that Porter et al. does not expressly teach a system of merging the functionality of indices of databases. The Examiner has applied Nishiyama et al. for its contended teaching of a system merging the functionality of indices of databases, thereby teaching that not taught by Porter et al., however, the Examiner has conceded that Nishiyama et al. does not expressly teach a document management extension system and tight integration. Tada et al. has, therefore, been cited and applied by the Examiner for disclosing a document management extension system and tight integration, *i.e.*, allegedly teaching that which is not taught by Nishiyama et al. Combining the teachings of Porter et al., Nishiyama et al. and Tada et al., in the manner suggested by the Examiner, is obvious to the skilled artisan according to the Examiner.

In reply to the Examiner's obviousness rejection applying Porter et al., Nishiyama et al., and Tada et al., the initially applied citation of Porter et al. discloses a messaging system for storing profile (or index) data, but stores the content of a document in a file system, while the profile of the document is stored in a messaging system, as taught by the Abstract of Porter et al., and does not disclose the concept of a system (or software) that merges the functionality of indices of databases, as agreed by the Examiner. Storage of the content of the document in a file system is a fundamental distinction between Porter et al. and that which Applicants now claim.

Nishiyama et al. teaches a document retrieving method in a document managing system, which allows for catalog content management for viewing large catalogs by company name, product or document class (e.g., brochure, image, etc.) Nishiyama et al. is not a document management system that allows the object to be viewed, sorted and displayed by any metadata element, including security elements and text contained within the document itself, as is the case with the presently claimed document management extension system of Applicants. Nishiyama et al. also fails to disclose or suggest a document management extension system for a messaging system.

Tada et al. is, apparently, an extensible document management system, whereas Applicants' document management software/system is a document management extension system, which is an extension for existing messaging systems, and in this regard, entirely distinct from that disclosed and being claimed by Applicants.

Each of Porter et al., Nishiyama et al. and Tada et al. differ in one or more fundamental ways from that which the instant Applicants are now claiming and, as such, Applicants respectfully submit that combining them in the manner suggested by the Examiner would fail to yield that which Applicants claim. Porter et al. uses a messaging system to store the profile (index) data, but stores the content of the docu-

ment in a file system, while neither Porter et al., Nishiyama et al., nor Tada et al. teach or suggest a document management extension system with tight integration and, thus, cannot render obvious that which Applicant now claim.

Accordingly, withdrawal of the Examiner's 35 U.S.C. §103(a) obviousness rejection of the subject matter of original Claims 1-34 (now Claims 35-64) is respectfully requested.

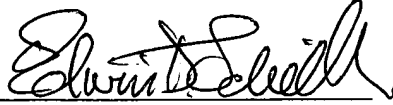
Concerning, finally, the remaining reference made of record by the Examiner, but not applied in any rejection of Applicants' claims, such additional art reference has been carefully considered, but are not believed to adversely affect the patentability of the present invention, as claimed.

In view of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (i.e., Claims 35-64) recite a novel and efficient document management extension software program, for management of documents in organizations of all sizes, and which may usefully be employed with, for example, Microsoft Exchange, which is patentably distinguishable over the prior art. Accordingly, withdrawal of the outstanding objections

and rejection and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

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Enc.: Abstract of the Disclosure.

The Commissioner is hereby authorized to charge the Deposit Account of Applicants' Attorney, Account No. 19-0450, for any additional fees which may be due in connection with the prosecution of the present application, but which have not otherwise been provided for.

ABSTRACT OF THE DISCLOSURE

A document management extension system for use as an extension to document collection and management software, includes a database for documents managed by the document collection and management software and provides in the database document indexing and processing of the stored documents.